

Serial No. 09/807,664
Art Unit: 1764

"Becker '709"). The Examiner contends that Becker '709 teaches a composition containing C₈₋₂₂ fatty acid methyl esters for lubricating textile fibers, noting that coconut oil and palm oil are specifically mentioned as starting materials for esterification to obtain the taught methyl esters. (Paper No. 7, p. 2). The Examiner acknowledges that Becker '709 does not teach the use of the methyl esters for wool fibers. (*Id.*). However, the Examiner argues that the intended use of a composition is of no avail in determining the patentability of the composition *per se*. The Examiner argues that the disclosure of a lubricant composition for textile fibers containing fatty acid methyl esters and emulsifiers renders Applicants' claimed invention obvious.

Applicants strenuously, but respectfully, traverse the Examiner's rejection and the arguments and contentions set forth in support thereof, for the following reasons.

It is well-settled that in order to establish a *prima facie* case of obviousness based upon a single reference, and thus shift the burden of proving non-obviousness onto Applicants, each of the following three criteria must be satisfied: (1) the reference must contain a teaching or suggestion which would motivate one of ordinary skill in the art to modify the reference as suggested by the Examiner (it is not sufficient to say that the reference can be combined without a teaching in the cited reference to suggest the desirability of such a modification); (2) there must be a reasonable expectation of success; and (3) the reference must teach or suggest each and every element of Applicant's claimed invention. (M.P.E.P. §2143).

To begin with, the rejected claims are directed to lubricant compositions comprising: a mixture of C₆₋₂₂ fatty acid methyl esters *consisting essentially of* esters derived from fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof; and emulsifiers. The compositions according to Applicants' claimed invention comprise methyl esters based on fatty acids which are vegetable oil-derived.

Becker '709 discloses fatty acid methyl esters based on C₈₋₂₂ fatty acids. The fatty acid methyl esters are disclosed as smoothing agents for use in lubricant compositions for card spinning. (*See*, Becker '709, col. 1, lines 51-53). Becker '709 discloses that suitable fatty acid methyl esters can be obtained, "by transesterification of natural triglycerides, such as

Serial No. 09/807,664
Art Unit: 1764

coconut oil, . . . palm oil and tallow, . . .” (*See, id.*, at col. 1, lines 59-62). Becker ‘709 specifically exemplifies the use of tallow fatty acid methyl esters.

Becker ‘709 does not teach or suggest that the disclosed smoothing agents be limited to fatty acid esters based on vegetable oils. In fact, based upon the Examples set forth in Becker ‘709, it would appear that the reference actually teaches away from the exclusion of animal based fatty acids by specifically including tallow based materials.

Accordingly, Applicants submit that Becker ‘709 does teach or suggest each and every element of the claimed invention. Specifically, Becker ‘709 fails to teach or suggest mixtures of C₆₋₂₂ fatty acid methyl esters *consisting essentially of* esters derived from fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof. Applicants also submit that Becker ‘709 contains no teaching or suggestion which would motivate one of ordinary skill in the art to modify the reference to limit the smoothing agents to vegetable oil based fatty acid methyl esters. Finally, one of ordinary skill in the art would find no expectation of success in such a modification, based upon the reference, when tallow is specifically included in the examples set forth therein.

Accordingly, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness, as none of the three criteria necessary to establish a *prima facie* case of obviousness has been satisfied. Thus, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a).

Serial No. 09/807,664
Art Unit: 1764

In view of the remarks set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration, withdrawal of the rejection and a Notice of Allowance for all pending claims are respectfully requested.

Respectfully submitted,

WOLFGANG BECKER, et al.

June 10, 2002
(Date)

By: _____

AARON R. ETTELMAN

Registration No. 42,516

COGNIS CORPORATION

2500 Renaissance Blvd., Suite 200

Gulph Mills, PA 19046

Telephone: (610) 278-4930

Facsimile: (215) 278-4971

E-Mail: AARON.ETTELMAN@COGNIS-US.COM

ARE:are

G:\AMEND\H3624.REQ-RECON.DOC